

CA9-99-017

PATENT

REMARKS

Claims 1-43 are pending in the Application.

Claims 14, 15 and 37-39 have been withdrawn from consideration and are cancelled hereinabove.

Claims 1-13, 16-22, 24-36 and 40-43 stand rejected.

Claim 23 stands objected to.

I. WITHDRAWN SUBJECT MATTER

In response to the election restriction in Paper No. 5, the Applicants have hereinabove cancelled the withdrawn subject matter, claims 14, 15, 37, 38 and 39.

II. ALLOWABLE SUBJECT MATTER

Claim 23 has been objected to as being dependent upon a rejected base claim but is deemed allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. The Applicant appreciates the Examiner's finding of allowability of claim 23.

III. REJECTION UNDER 35 U.S.C. § 103

Claims 1-8, 10-12, 16, 17, 19, 24-31, 33-35, 40, 42 and 43 have been rejected under 35 U.S.C. § 103 as being unpatentable over Word '97 screen shots, numbered pages 1-16 ("*Word '97*"). The Applicant respectfully traverses the rejections of claims 1-8, 10-12, 16, 17, 19, 24-31, 33-35, 40, 42 and 43 under 35 U.S.C. § 103.

Claim 1 is directed to a method for formatting a document. The method includes receiving a user example, and formatting the non-functional aspects of the document in the style of the user example. The Examiner asserts that *Word '97* teaches the limitations of claim 1 because *Word '97* analyzes user example input such as "Dear John" whereby the system determines that one is attempting to write, or format a letter. (Paper No. 7, page 3.) The Applicant respectfully disagrees.

CA9-99-017

PATENT

*Word '97* is not analyzing anything. The "Letter Wizard" only appears in response to "Dear" or "To" followed by a colon or a comma with a person's name disposed between the two. (*Word '97*, page 7.) This is a simple pattern matching. (This could trivially be performed with a regular expression engine, however, such an implementation is probably overkill.) In other words, the Letter Wizard responds to nothing other than an "Dear" or "To" followed by a colon or a comma. (*Id.*) Additionally, *Word '97* does not teach formatting non-functional aspects of the document in the style of the user example. *Word '97* teaches that in response to a "Dear" or "To" followed by a colon or a comma, the Letter Wizard asks the user if they would like help writing the letter. (*Word '97*, page 9) If the user chooses to receive help, Letter Wizard presents a selection of letter styles to choose from. (*Word '97*, page 10.) These are predetermined styles which have nothing to do with the non-functional aspects of example input. Indeed, the only input that has been received is the "Dear John", which contains no style information whatsoever. Additionally, the "Dear John" is a functional, not a non-functional aspect of the user input. Thus, the teaching in *Word '97* does not support the Examiner's contention that the "Full block" letter style as a default choice attempts to approximate the letter style display of the user input. The displayed letter style is simply the first style displayed from a set of choices as indicated by the drop-down menu in the Letter Wizard dialog box. (*Word '97*, page 10.)

Moreover, the Examiner agrees that *Word '97* does not disclose formatting non-functional aspects in the style of the example as recited in claim 1. (Paper No. 7, page 3.) Nevertheless, the Examiner asserts that it would have been obvious to one of ordinary skill in the art of the time of the invention to interpret *Word '97* as attempting to approximate the letter style display of the user input, therefore providing the claimed equivalents of the limitations of claim 1. (Paper No. 7, page 3.) However, a rejection under 35 U.S.C. § 103 for obviousness is not whether it would have been obvious to interpret a reference in some way, but whether the claimed invention is obvious. A *prima facie* showing of obviousness requires, at least, that the reference teach or suggest all of the limitations of claim 1.

CA9-99-017

PATENT

MPEP § 2143.03. *Word '97* admittedly does not teach or suggest all of the limitations of claim 1, and, the explicit disclosure of *Word '97* plainly shows that it does not teach or suggest the invention of claim 1.

Additionally, a *prima facie* showing of obviousness requires that there be some motivation or suggestion to modify the reference to make the claimed invention. MPEP § 2143.01. This suggestion must be found in the reference itself, the knowledge of persons of ordinary skill in the art, or the nature of the problem to be solved. *Id.* The Examiner asserts, as previously discussed, that it would have been obvious to one of ordinary skill in the art to interpret *Word '97* as attempting to approximate the letter style display of the user input thereby providing the claimed equivalents of formatting non-functional aspects in the style of the user example. (Paper No. 7, page 3.) A interpretation of a reference is not a modification of a reference. There is no basis under 35 U.S.C. § 103 for a claim rejection on the ground of obvious to interpret. (See MPEP § 2143) (stating the requirements of a *prima facie* showing of obviousness.) Furthermore, the rationale for interpreting *Word '97* in the aforementioned fashion is to provide *Word '97* the benefit of offering various style selections for convenience of document construction. (Paper No. 7, page 3.) However, this is not a suggestion found in one of the three possible sources thereof. Furthermore, broad conclusory statements regarding the teachings of the references, without more, are not evidence. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d, 1430, 1433-34 (Fed. Cir. 2002). There is no reason to modify *Word '97* to provide the benefit offering various style selections for convenience of document construction because *Word '97* offers a choice of predetermined letter styles via a drop-down menu as explicitly shown therein. (*Word '97*, page 10.) However, *Word '97* does not disclose formatting non-functional aspects in the style of a user example. There is no user example.

Lastly, a *prima facie* showing of obviousness requires that there be some reasonable expectation of success in modifying the reference to make the claimed invention. MPEP § 2143.02. The reasonable expectation of success must be found in

CA9-99-017

PATENT

the reference itself. *Id.* No reasonable expectation of success in modifying the reference has been identified. (See Paper No. 7, page 3.)

Thus, for at least the aforesaid reasons, a *prima facie* showing of obviousness has not been made with respect to claim 1. Therefore, claim 1 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 2 is directed to the method of claim 1 wherein the non-functional aspects include indentation, order, and comment style. With respect to claim 2, the Examiner asserts that *Word '97* teaches "Full block" and "Modified block" indentation styles, as well as order (header and footer inclusions) and space for inputting mailing instructions, attention and subjects. (Paper No. 7, page 3) (citing *Word '97*, pages 10, 11 and 14). However, these are not non-functional aspects formatted in a style of a user example. Indeed, the only user input identified in *Word '97* is "Dear John" which plainly shows that the "Full block" and "Modified block" indentation styles are not formatting in the style of the user example. Because *Word '97* does not teach or suggest all of the limitations of claim 2, nor is there a motivation for modifying *Word '97* to make the invention of claim 2, claim 2 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 2 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 3 is directed to a method for formatting an output document. The method includes receiving from a user an example document, selectively generating from the example document style templates, alignment offsets and section order, and responsive to the templates, offsets and order, formatting functional aspects of the output document. Claim 3 is rejected on the same rationale as claim 1. (Paper No. 7, page 3.) The Examiner further asserts that *Word '97* teaches generation of various style templates based upon a user's initial attempt at writing a letter. (Paper No. 7, page 3) (citing *Word '97*, pages 4, 10 and 11). However, the users attempt at writing a letter is not a step of receiving from a user an example document. Again, as the Applicant has previously demonstrated, *Word '97* pops up a Letter Wizard in response to the user inputting a salutation in a very specific format. In other words,

CA9-99-017

PATENT

*Word '97* does a simple pattern match to pop up the Letter Wizard which then offers some exemplary predetermined document styles from which the user can select. These are not selectively generated from the example document. There is no example document received from the user.

The Examiner also asserts that *Word '97* teaches reformatting of inputted text and inclusion of macros to fit the form of a selected letter style. Again, the selected letter style is not an example document received from a user. Furthermore, macros are sets of actions that automate the performance of repetitive operations. Macros are not functional aspects of the output document.

With respect to the alignment offsets and section order as recited in claim 3, the Examiner admits that *Word '97* does not teach alignment offsets. (Paper No. 7, page 3.) Nevertheless, again, the Examiner asserts that it would have been obvious to interpret *Word '97* as incorporating offsets. (Paper No. 7, page 4.) However, there is no basis for a rejection under 35 U.S.C. § 103 to engraft therein by interpretation disclosure admittedly missing in the reference. See MPEP § 2143, (stating the requirements for a *prima facie* showing of obviousness). The "modified block" style including block indentations are not alignment offsets generated from an example document. Furthermore, the screen shots in *Word '97* depicting the "modified block" letter style do not appear to show block indentations at all. (*Word '97*, page 11.) Although the illustrations are low resolution, the depiction of the text in the letter style appears to be fully justified with paragraphs separated by additional line spacing, and without indentations. (*Word '97*, page 11.) Additionally, the Examiner's motivation for interpreting *Word '97* as incorporating offsets is the same as that discussed in conjunction with claim 1, and does not support a *prima facie* showing of obviousness. (See Paper No. 7, page 4.)

Consequently, for at least the aforesaid reasons, claim 3 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 3 is allowable under 35 U.S.C. § 103 over *Word '97*.

CA9-99-017

PATENT

Claim 4 is directed to a method for generating an output document in a user preferred style. The method includes capturing the user preferred style from a user example document, and generating a plurality of templates, each template representing a component of the user example document and selectively including replaceable macros. Claim 4 has been rejected on the same rationale as claim 3 and on the teaching of macro inclusion in templates, and a method of selecting alternate salutations. (Paper No. 7, page 4.) The Examiner also asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret *Word '97* as selectively including replaceable macros. There is no rationale for interpreting *Word '97* as selectively including replaceable macros and particularly, not replaceable macros in a template representing a component of the user example document as recited in claim 4. Selecting alternate salutations from a drop-down menu is not selectively including replaceable macros. (See *Word '97*, page 16.) A salutation pasted into a document from a drop-down menu is not a macro. There is no teaching in *Word '97* disclosing or suggesting generating a plurality of templates from a user example document. Because *Word '97* does not teach or suggest all of the limitations of claim 4, and because there's no suggestion or motivation for one of the possible sources thereof for modifying *Word '97* to make the invention of claim 4, claim 4 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 4 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 5 is directed to the method of claim 4 and further including generating functional aspects, replacing the macros in the template with information from the functional aspects, and responsive to the template with information from the functional aspects, generating the output document. With respect to claim 5, the Examiner asserts that *Word '97* teaches reformatting of inputted text an inclusion of macros (functional aspects) to fit the form of the selected letter style. (Paper No. 7, page 4.) The Examiner also relies on the teaching in *Word '97* for selecting alternate salutations using a drop-down menu. (Paper No. 7, page 40 (citing *Word '97*, pages 4, 13 and 16.) Whether *Word '97* teaches reformatting of inputted text and inclusion of macros to fit the form of a selected letter, or otherwise, these allegations

CA9-99-017

PATENT

do not address the limitations of claim 5. Claim 5 does not recite reformatting inputted text and inclusion of macros to fit a form of selected letter. Claim 5 recites, *inter alia*, replacing macros in a template with information from the functional aspects, and responsive to the template with information from the functional aspects, generating the output document. All words in a claim must be considered when judging the patentability of the claim, and all limitations must be taught or suggested by the reference. MPEP § 2143.03. Likewise, selecting alternate salutations from a drop-down menu is not replacing a macro in a template with information from functional aspects. The technique of string substitution from a drop-down menu is common place in the data processing art, and simply copies the string associated with the menu item into the document data stream. Such a mechanism would not be recognized in the art as replacing a macro in a template with information from the functional aspects. Because *Word '97* does not teach or suggest all of the limitations of claim 5, nor is there a motivation or suggestion from one of the possible sources thereof for modifying *Word '97* to make the invention of claim 5, claim 5 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 5 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 6 is directed to the method of claim 4 or claim 5, and further including the step of applying syntactical patterns to the user example document to define the component. The Examiner asserts that *Word '97* teaches analysis of user input "Dear John," the analysis dependent upon syntactical review of the punctuation of the input. (Paper No. 7, page 4) (citing *Word '97*, page 2). There is no such teaching in *Word '97*. *Word '97* simply states that if a salutation starts with "Dear" or "To" and followed by a colon or comma as previously discussed, *Word '97* pops up a Letter Wizard that allows the user to select a letter style from a predetermined set of letter styles using a drop-down menu. There is no particular implementation described in *Word '97*, however, it would be recognized by persons of ordinary skill in the art that a simple pattern recognition mechanism may be used. One such pattern recognition mechanism may, as previously noted, use a regular expression engine as is known in the data processing art. For at least the reason that *Word '97* does not teach or

CA9-99-017

PATENT

suggest all of the limitations of claim 6, nor is there a motivation or suggestion from one of the possible sources thereof for modifying *Word '97* to make the invention of claim 6, claim 6 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 6 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 7 is directed to the method of claim 6 and further including the step of temporarily removing comments from the user example document when applying the syntactical patterns to the user example document. Claim 7 has been rejected on the basis that *Word '97* teaches alteration of "mailing instructions" "Attention", and "Subject" fields as well as creating auto text after applying pattern matching. (Paper No. 7, page 5) (citing *Word '97*, pages 14, 16). While *Word '97* may teach alteration of "mailing instructions", "Attention" and "Subject" fields, by selecting from a list box in a dialog window, this does not teach temporarily removing comments from the user example document when applying syntactical patterns to the example document, as recited in claim 7. It would be appreciated by persons of ordinary skill in the art that selecting elements such as a reference line or subject field simply copies the text in the list box into the letter being written. (See *Word '97*, pages 14, 16) (illustrating the Letter Wizard dialog box and list box contained therein). Similarly, creating auto text does not disclose the limitations of claim 7, as stated in *Word '97*, creating auto text allows the user to add names to a list of names and text to be used in standard letter elements. (*Word '97*, page 5.) Thus, *Word '97* does not teach or suggest all of the limitations of claim 7. Neither is there a motivation from one of the possible sources thereof for modifying *Word '97* to make the invention of claim 7. Consequently, claim 7 is not *prima facie* obvious in view of *Word '97* and therefore, is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 8 is directed to the method of any one of claims 4 to 7, the output document including a plurality of separately generated sections. With respect to claim 8, the Examiner asserts that *Word '97* teaches various sections of a document. (Paper No. 7, page 5) (citing *Word '97*, pages 10-15). Whether *Word '97* teaches various sections of a document, as alleged, or otherwise, the allegation does not reach the limitations of claim 8. Claim 8 recites an output document including a plurality of



CA9-99-017

PATENT

separately generated sections. All words in the claim must be considered when judging the patentability of the claim. MPEP § 2143.03. Because *Word '97* is neither alleged to nor does teach or suggest all of the limitations of claim 8, claim 8 is not *prima facie* obvious in view of *Word '97*. Moreover, there is no motivation or suggestion for modifying *Word '97* to make the invention of claim 8 from one of the possible sources thereof. Consequently, claim 8 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 10 is directed to the method of any one of claims 4 to 9 and further comprising the step of receiving from the user further input changing the style of the user example document. As an initial matter, claim 10 is a multiple dependent claim, depending from any one of claims 4 to 9. Because claim 9 has not been rejected under 35 U.S.C. § 103 over *Word '97* alone, the invention of claim 10 incorporating the limitations of claim 9 by reference is not *prima facie* obvious in view of *Word '97* alone.

With respect to the express limitation of claim 10, the Examiner asserts that *Word '97* teaches revising a final document (changing its style) using a right click feature in combination with a replaceable function that is a macro feature. (Paper No. 7, page 5.) However, revising a final document is not changing a document style and in particular is not a step of receiving from the user further input changing the style of the user example document as recited in claim 10. Furthermore, inserting a particular salutation from a drop-down list of stored salutations as illustrated in *Word '97*, is not a replaceable function feature. (See *Word '97*, page 16.) (If, for the sake of argument, this were a replaceable function feature, it is not germane to the limitation of claim 10 as it does not disclose receiving from the user further input changing the style of the user example document.) Because *Word '97* does not teach or suggest all of the limitations of claim 10, including, in particular, the express limitation of claim 10, claim 10 is not *prima facie* obvious in view of *Word '97*. Additionally, there is no motivation or suggestion for modifying *Word '97* to make the inventions of claim 10. For at least these reasons, claim 10 is allowable under 35 U.S.C. § 103 over *Word '97*.

CA9-99-017

PATENT

Claim 11 is directed to the method of any one of claims 4 to 10, wherein the replaceable macros correspond to text in the user example document. Again, as an initial matter, claim 11 is a multiple dependent claim depending from, *inter alia*, claims 9 and 10. As previously discussed, claim 9 has not been rejected over teaching in *Word '97* alone. Therefore, any of the inventions of claim 11 incorporating the limitations of claim 9 cannot be *prima facie* obvious in view of *Word '97* alone.

With respect to the express limitation of claim 11, the Examiner asserts that *Word '97* teaches a replaceable function feature that is a macro. (Paper No. 7, page 5) (citing *Word '97*, page 16). As previously discussed, page 16 illustrates the selection of a salutation in a letter from a drop-down list of salutations previously used by the user. This has nothing to do with macros whatsoever. Therefore, *Word '97* does not teach or suggest all of the limitations of claim 11. Furthermore, no motivation or suggestion for modifying *Word '97* to make the invention of claim 11 has been provided from one of the three possible sources thereof. Consequently, for at least these reasons, claim 11 is not *prima facie* obvious, and therefore, is allowable under 35 U.S.C. §103 over *Word '97*.

Claim 12 is directed to a method for generating an output document with indentation of document components in a user preferred style. The method includes receiving a user example document, while parsing document components in the user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for the subcomponents, and responsive to the user desired offsets, generating the output document. The Examiner relies on the teaching in *Word '97* of a "Modified block" style template alleged to comprise various calculated block indents in which the desired application of the template to a user document preserves the indents to produce a final document. (Paper No. 7, page 5) (citing *Word '97*, page 11). *Word '97* teaches a sample letter style including a modified block letter style selected from a set of predetermined letter styles. (*Word '97*, page 11.) There is nothing disclosed therein with respect to calculating various block indents or receiving a user example document, and while parsing document

CA9-99-017

PATENT

components in the example document preserving the relative indentation of subcomponents, as recited in claim 12.

Indeed the Examiner admits that *Word '97* does not teach parsing components. (Paper No. 7, page 5.) The Examiner contends that *Word '97* teaches analyzing user inputted words and punctuation which provides the claimed equivalent of parsing text components. The Applicant respectfully disagrees. As previously discussed, *Word '97* detects the presence of an "Dear" or "To" followed by a comma or colon, and launches the Letter Wizard in response thereto. This discloses, at best, a simple pattern matching against a predetermined string which would not be understood to disclose parsing document components in a user example document. As also previously discussed, there is no user example document disclosed in *Word '97*. Thus, the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time of the invention to interpret *Word '97* as providing the equivalent of parsing text components is not justified. Furthermore, obviousness is not shown by interpreting a reference to meet the claim limitations but by what a reference actually teaches. The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee*, 277 F.3d at 1343-44, 61 U.S.P.Q.2d at 1434. Furthermore, asserting that modifying *Word '97* to make the invention of claim 12 to provide the benefit of text analysis/matching for presentation of various templates is not sufficient to support a *prima facie* showing of obviousness. The teachings of a motivation must be clear and particular, and broad conclusory statements regarding the teachings standing alone are not evidence. *Id.* at 1343, 61 U.S.P.Q.2d at 1433-34. Because *Word '97* does not teach or suggest all of the limitations of claim 12, nor is there a motivation for modifying *Word '97* to make the invention thereof, claim 12 is not *prima facie* obvious in view of *Word '97*. Consequently, claim 12 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 16 is directed to a computer program product for generating an output document in a user preferred style, the computer program product includes:

CA9-99-017

PATENT

a style capture tool for examining an input document containing an example of the user preferred style to determine the user preferred style for non-functional aspects of the output document; a code generation tool for generating functional aspects of the output document; and a document generate tool responsive to the style capture tool and the code generation tool for generating the output document with the preferred style for non-functional aspects applied to the presentation of the functional aspects.

Claim 16 has been rejected on the grounds that claim 16 reflects computer readable instructions for performing the methods of claim 3. (Paper No. 7, page 6.) However, as an initial matter, the limitations of claim 16 do not only parallel the limitations of claim 3 as computer constructions for performing the methods of claim 3. For example, claim 3 does not recite determining a user preferred style for non-functional aspects of an output document generating functional aspects of the output document (claim 3 recites formatting functional aspects of the output document) or generating the output document with the preferred style for non-functional aspects applied to the presentation of the functional aspects. These elements of claim 16 have not been expressly addressed. The Examiner states that while *Word '97* does not specifically disclose formatting non-functional aspects in the style of the example, *Word '97* teaches a "Full block" letter style as a default choice. (Paper No. 7, page 6) (citing *Word '97*, page 10). As previously discussed hereinabove in conjunction with, *inter alia*, claim 1, this teaching in *Word '97* has nothing to do with formatting, or generating non-functional aspects in the style of an input document containing an example of a user preferred style. The teaching in *Word '97* discloses that the Letter Wizard offers the user a drop-down menu selection of predetermined letter styles. (*Word '97*, page 11.) Thus, the "Full block" letter style does not attempt to approximate the letter style display of the user input, but is simply one choice from a predetermined set of choices of letter style offered to the user by *Word '97*. Consequently, there is no justification for interpreting *Word '97* to teach the limitations of claim 16, and the stated motivation for doing so, the "benefit of offering various style selections or convenience of document construction" is not

CA9-99-017

PATENT

sufficient to support a *prima facie* showing of obviousness. (Paper No. 7, page 6.) Thus, for at least the aforesaid reasons, claim 16 is not *prima facie* obvious in view of *Word '97*. Therefore, claim 16 is allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 17 is directed to the computer program product of claim 16 and further including a grammar template for storing syntax rules, the style capture tool being responsive to the syntax rules for pattern-matching the user example document. The Examiner admits that *Word '97* does not teach a grammar template for storing syntax rules. (Paper No. 7, page 6.) The Examiner asserts that *Word '97* teaches analysis of user input "Dear John," in which the analysis is dependent upon syntactical and pattern matching review of words and punctuation of the input. (*Id.*) The Applicant respectfully disagrees that the analysis is dependent upon syntactical matching, and moreover, that notwithstanding, there is no disclosure in *Word '97* with respect to a grammar template. As the Applicant has previously discussed, the teaching in *Word '97* discloses that the Letter Wizard is launched in response to user inputting "Dear" or "To" followed by a comma or a colon. (*Word '97*, page 7.) Letter Wizard will not start if anything else is entered. (*Id.*) The starting of Letter Wizard can be responsive to a simple pattern matching and need not rely on syntactical rules. Thus, *Word '97* does not teach or suggest all of the limitations of claim 17, and the deficiencies in *Word '97* cannot be cured by interpreting the reference to teach the limitation of claim 17. Neither is there a motivation or suggestion to modify *Word '97* to make the invention of claim 17. The "benefit of rules for making accurate analysis" is not a clear and particular suggestion or motivation, as required. *See In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433-34. Thus, claim 17 is not *prima facie* obvious in view of *Word '97* and is thus, allowable under 35 U.S.C. § 103 over *Word '97*.

Claim 19 is directed to the computer program product of any one of claims 16 to 18, and further including a plurality of input document files, each input document file representing a user preferred style for different parts of the output document. Claim 19 has been rejected on the teaching in *Word '97* of a Letter Wizard that can be used to modify or complete existing letters, each letter of incorporating various

CA9-99-017

PATENT

customized template portions. Whether *Word '97* teaches such, a Letter Wizard or otherwise, is immaterial to the rejection of claim 19. Claim 19 recites a plurality of input document files, each input document file representing a user preferred style for different parts of the output document. Thus, the Letter Wizard as taught by *Word '97* and as reflected in the application thereof to the rejection of claim 19 does not teach or suggest the limitations of claim 19. Neither is there a motivation or suggestion from one of the possible sources thereof for modifying *Word '97* to make the invention of claim 19. Consequently, claim 19 is not *prima facie* obvious in view of *Word '97*, and is, thus, allowable under 35 U.S.C. § 103 over *Word '97*.

Claims 24-31 have been rejected as being drawn to a computer program product comprising computer readable instructions for performing the method steps of claims 1-8, respectively. (Paper No. 7, page 7.) Consequently, for at least those reasons discussed in conjunction with claims 1-8, the Applicant also respectfully asserts that claims 24-31 are not *prima facie* obvious in view of *Word 97*. Thus, claims 24-31 are allowable under 35 U.S.C. § 103 over *Word 97*. Likewise, claims 33-35 have been rejected as being drawn to a computer program product comprising computer readable instructions for performing the method steps of claims 10-12, respectively. (Paper No. 7, page 7.) Therefore, for at least those reasons discussed in conjunction with claims 10-12, the Applicant also respectfully asserts that claims 33-35 are not *prima facie* obvious in view of *Word 97*. Thus, claims 33-35 also are allowable under 35 U.S.C. § 103 over *Word 97*.

Claim 40 has been rejected as being drawn to system operable to perform the method steps of claim 16. (Paper No. 7, page 7.) Consequently, for at least those reasons discussed in conjunction with claim 16, the Applicant also respectfully asserts that claim 40 is not *prima facie* obvious in view of *Word 97*. Thus, claim 40 are allowable under 35 U.S.C. § 103 over *Word 97*. Likewise, claims 42 and 43 have been rejected as being drawn to a system operable to perform the method steps of claims 4 and 5, respectively. (Paper No. 7, page 7.) For at least those reasons discussed in conjunction with claims 4 and 5, the Applicant also respectfully asserts

CA9-99-017

PATENT

that claims 42 and 43 are not *prima facie* obvious in view of *Word 97*. Thus, claims 42 and 43 also are allowable under 35 U.S.C. § 103 over *Word 97*.

IV. REJECTION UNDER 35 U.S.C. § 103:

Claims 9, 13, 18, 20, 21, 32 and 36 have been rejected under 35 U.S.C. § 103 as being unpatentable over *Word '97* and in further view of *Turbo C++V4.5*, 1995, Borland International screen shots, pages 1-7 ("*Borland*"). The Applicant respectfully traverses the rejection of claims 9, 13, 18, 20, 21, 32 and 36 under 35 U.S.C. § 103.

Claim 9 is directed to the method of any one of claims 4 to 8 and further including the steps of determining from the user example document a user preference for group order, and generating the output document with public, protected, and private member access in the user preference order. The Examiner contends that *Word '97* teaches group ordering in disclosing a header and footer. (Paper No. 7, page 7.) The Examiner admits that *Word '97* does not teach public, protective and private member access associated with an order. (Paper No. 7, page 7.) Considering the assertions with respect to group order, the Examiner provides no rationale explaining how a header and a footer teach the recited group order, and moreover, claim 9 is not directed to "group order" standing alone. Claim 9 recites determining from the user example document a user preference for group order. As previously discussed, there is no teaching in *Word '97* respecting a user example document and, consequently, there can be no teaching and there is no teaching with respect to determining from a user example document, a user preference for group order. Certainly, there is no teaching in *Word '97* that a header and footer are determined from a user example document, and no such teaching would be expected as there is nothing to "order" with respect to a header and footer, by definition. A header is at the top of the page and a footer at the bottom; there is nothing to determine with respect to a user preference. With respect to the public, protected and private member

CA9-99-017

PATENT

access as recited in claim 9, the Examiner looks to *Borland* to cure the admitted defects in *Word '97*. (Paper No. 7, page 7.) The Examiner refers to teaching in *Borland* disclosing the customization of reserve words, for example by color or underlining, with the reserve words comprising "public," "private" and "protected." (Paper No. 7, page 7.) Although the Applicant does not dispute that "public," "private" and "protected" are reserved words in C++, there is no teaching in *Borland* referring to "public," "private" and "protected," there is no teaching in *Borland* that discloses or suggests generating an output document with public, private and protected member access in user preference order. The Examiner contends that the customization of coloring, etc., to reserved words can be interpreted as a form of prioritized ordering. (Paper No. 7, page 7.) There is no support whatsoever for the Examiner's interpretation of coloring or other highlighting of reserved words as a prioritized ordering and the Examiner provides no evidence whatsoever in support of the assertion. Coloring or highlighting is not ordering. Furthermore, there is no teaching or suggestion in *Borland* with respect to generating an output document with public, protected and private member access in a user preference order. Therefore, there is no evidentiary support for the Examiner's allegation that it would have been obvious to one of ordinary skill in the art at the time of the invention to apply *Borland's* ordering/prioritization of C++ text to *Word '97* templates to provide *Word '97* with the benefit of enhancing its templates to accommodate various text files. (See Paper No. 7, page 7-8.) There is no ordering/prioritization of C++ text of *Borland*. *Borland* simply teaches syntax highlighting that lets the user choose the color and style of text that the editor uses to display syntax elements in C++ source code. (*Borland*, page 6.) Therefore, there is nothing to incorporate into *Word '97* to enhance its templates to accommodate various text files. Moreover, such a motivation or suggestion to modify *Word '97* to make the invention of claim 9 does not arise at one of the three possible sources thereof, and is not evidence. See MPEP § 2143.01; *In re Lee*, 277 F.3d at 1343, 61 U.S.P.Q.2d at 1433-34. Thus, neither *Word '97* nor *Borland*, alone or in combination teach or suggest all of the limitations of claim 9. Furthermore, there is no motivation or suggestion for



CA9-99-017

PATENT

modifying or combining the references to make the invention of claim 9. Therefore, claim 9 is not *prima facie* obvious in view of *Word '97* and *Borland* is therefore allowable under 35 U.S.C. § 103 over *Word '97* and *Borland*.

Claim 13 is directed to the method of claim 12, the user desired offsets being preserved for variables, functions, and constructors. Claim 13 has been rejected on teaching in *Borland* that discloses an auto indent mode and persistent blocks for preserving indentation of blocks of code. (Paper No. 7, page 7.) Referring first to the persistent blocks, when the persistent blocks option is on, marked blocks remain selected until they are deleted or unmarked or another block is selected. Otherwise, with this option off, moving the cursor after a block that is selected deselects the entire block of text. (*Borland*, page 4.) Therefore, persistent blocks have nothing to do with the preservation of indentation of blocks of code. With respect to the auto indent mode, when auto indent mode is on in *Borland*, pressing enter in an edit window positions the cursor under the first non-blank character in the preceding non-blank line. Thus, this teaching in *Borland* does not disclose preserving user desired offsets for variables, functions and constructors. Neither does it disclose while parsing a user example document, preserving the relative indentation of subcomponents by calculating user desired offsets for the subcomponents, as recited in claim 12 from which claim 13 depends. Plainly, neither *Word '97* nor *Borland* teach or suggest all of the limitations of claim 13. Additionally, the motivation for modifying or combining the references to make the invention of claim 13 is the same as that discussed in conjunction with claim 9 above. (Paper No. 7, pages 7-8.) For the reasons discussed in conjunction with claim 9, this motivation does not sustain a *prima facie* showing of obviousness. For at least the aforesaid reasons, claim 13 is not *prima facie* obvious in view of *Word '97* and *Borland*. Therefore, claim 13 is allowable under 35 U.S.C. § 103 over *Word '97* and *Borland*.

Claim 18 is directed to the computer program product of claim 17 and further including a plurality of grammar templates, each template for storing syntax rules for a unique one of a plurality of programming languages. The Examiner admits that *Word '97* does not teach a grammar template for storing syntax rules. (Paper No. 7,

CA9-99-017

PATENT

page 8.) The Examiner contends, however, that *Word '97* teaches analysis of user input "Dear John," which analysis is dependent upon syntactical and pattern matching review of the words and punctuation of the input. (Paper No. 7, page 8) (citing *Word '97*, page 2). The Applicant has addressed this assertion in conjunction with claim 17. The Applicant has previously shown there is nothing in *Word '97* to suggest an analysis dependent upon syntactical and pattern matching review of words and punctuation of the input. In any case, there certainly is nothing that refers to syntax rules as recited in claim 18. Moreover, the Examiner's assertion is that it would be obvious to interpret *Word '97* this way does not state a basis of rejection under 35 U.S.C. § 103. An interpretation of a reference is not a teaching of a reference. A reference must be shown to teach or suggest the limitation of a claim, not interpret it to teach a limitation of the claim. See MPEP § 2143.03. The Examiner admits that *Word '97* does not teach rules for programming languages or of declaration/definition files. While the Applicants agree with the Examiner's statement, the statement is not pertinent to the invention of claim 18. Claim 18 does not refer to rules for programming languages or declaration/definition files. Claim 18 recites a template for storing syntax rules for a unique one of a plurality of programming languages. Neither does the allegation with respect to *Borland* as teaching an editor specifically tailored to edit text, as well as editing C++ text files comprising declaration/definition files address the limitations of claim 18. Again a text editor for editing declaration files is not a template for storing syntax rules for a unique one of a plurality of programming languages. Neither are declaration/definition files as would be recognized by persons of ordinary skill in the C++ programming art. Declaration/definition files, commonly referred to as header files, are not templates for storing syntax rules as recited in claim 18. As is well known in the art, C and C++ are strongly typed languages in which all variables, functions, etc. must be declared as to type before they are defined. Commonly this is done in a header file, and further, it is standard practice to denote header files with a .h file extension. Thus, neither *Word '97* nor *Borland*, alone or in combination, teach or suggest the limitations of claim 18. Thus, notwithstanding the Examiner's

CA9-99-017

PATENT

assertion that it would have been obvious to modify *Word '97* with *Borland's* rules and files associated with C++ to provide *Word '97* with the benefit of enhancing its templates to accommodate various text files, adding *Borland* to *Word '97* does not cure the deficiencies in *Word '97*. (See Paper No. 7, page 8.) Thus, claim 18 is not *prima facie* obvious in view of *Word '97* and *Borland* for at least the reason that the references, alone or in combination do not teach or suggest all of the limitations of claim 18 nor is there a motivation for modifying or combining the references to make the invention of claim 18. Therefore, claim 18 is allowable under 35 U.S.C. § 103 over *Word '97* and *Borland*.

Claim 20 is directed to the computer program product of claim 19, the input document files including a declaration example file and a definition example file. Claim 19 has been rejected on the teaching and assertions discussed in conjunction with claim 18. (Paper No. 7, page 8.) As recited in claim 19 from which claim 20 depends, the declaration and definition example files represent user preferred styles for parts of the output file. The Applicant does not dispute that the text editor of *Borland* might be used to edit declaration files, such as `stdio.h`. However, a text editor is not an input file nor is a C++ header file either a declaration example file nor a definition example file representing a user preferred style. Thus, neither *Word 97* nor *Borland* teach or suggest all of the limitations of claim 20. Neither is there a motivation or suggestion for combining or modifying the references to make the invention of claim 20 from one of the possible sources thereof. Consequently, for at least these reasons, claim 20 is not *prima facie* obvious in view of *Word 97* and *Borland* and claim 20 is allowable under 35 U.S.C. § 103 over *Word 97* and *Borland*.

Claim 21 is directed to the computer program product of any one of claims 16 to 20, wherein the code generation tool is operable for generating class declarations, and the style capture tool is operable for providing to the document generate tool rules for syntax and ordering of class-head, base-specifiers, class body, access-specifiers, and member-declarations. The Examiner admits that *Word '97* does not teach generation of class declarations, etc., as recited in claim 21. (Paper No. 7, page 8.) The Examiner relies on *Borland* as teaching a text editor specifically

CA9-99-017

PATENT

tailored to edit text and editing and dealing with the specialized constructs within C++ text files. (Paper No. 7, page 8) (citing *Borland*, pages 1, 6 and 7). However, a text editor is not a code generation tool and is not operable for generating class declarations. Neither is it a style capture tool operable for providing to the document generation tool, rules for syntax and ordering of class-head, base-specifiers, etc., as recited in claim 21. Text editors are software programs that create and edit files in response to keystrokes entered by the user and display the entered text on a display, and may save that text to a file in response to a user input command, such as "Save." Text editors, as understood in the art, are not a tool operable for generating class-declarations nor a tool operable for providing rules for syntax in ordering of class-head, base-specifiers, etc., as recited in claim 21. Thus, the Examiner's further assertion that it would have been obvious to apply *Borland's* rules and constructs associated with C++ to *Word '97* is unsupported by evidence. There are no teachings in *Borland* with respect to rules and constructs and in particular with respect to rules for syntax in ordering as recited in claim 21. Therefore, neither *Word '97* nor *Borland*, alone or in combination teach or suggest all of the limitations of claim 21, nor is there a motivation or suggestion for combining the references to make the invention of claim 21. Consequently, claim 21 is not *prima facie* obvious in view of *Word '97* and *Borland* and is allowable under 35 U.S.C. § 103 over *Word '97* and *Borland*.

Claims 32 and 36 have been rejected on the same grounds as claims 9 and 13, respectively, as being drawn to a computer program product for performing the methods as claimed in claims 9 and 13. Thus, for at least those reasons discussed in conjunction with claims 9 and 13, a *prima facie* showing of obviousness has not been made with respect to, respectively, claims 32 and 36. Therefore, claims 32 and 36 are also allowable under 35 U.S.C. § 103 over *Word '97* and *Borland*.

CA9-99-017

PATENT

V. REJECTION UNDER 35 U.S.C. § 103

Claims 22 and 41 have been rejected under 35 U.S.C. § 103 as being unpatentable over *Word '97* in view of *Borland*. The Applicant respectfully traverses the rejection of claims 22 and 41 under 35 U.S.C. § 103.

Claim 22 is directed to a computer program product for generating an output document, the computer program product comprising:

at least one grammar template file, one the grammar template file for each of one or more sections of an output document in one or more programming languages, each grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document; and at least one style template parsed from a user example document in a user preferred style using the grammar template file for defining the style of a section of the output document. The Examiner contends that *Word '97* teaches analysis of user input "Dear John," the analysis dependent upon syntactical and grammatical review of the words and punctuation of the input, which purportedly teaches the limitation in claim 22 directed to "grammar." (Paper No. 7, page 9.) The Applicants respectfully disagree for several reasons.

*Word 97* is alleged to teach the analysis of user input "Dear John," dependent upon syntactical and grammatical review of the words and punctuation of the input. (Paper No. 7, page 9) (citing *Word 97*, page 2). The Applicant respectfully disagrees. *Word 97* teaches that the user enters "Dear" or "To" followed by a name and colon or comma. (*Word 97*, page 2.) *Word 97* further teaches that if the Letter Wizard does not start in response, the user did not enter a comma or colon after the person's name or the user misspelled "Dear" or "To". (*Word 97*, page 7.) Plainly, there is no syntactical and grammatical review of the words and punctuation of the input taught in *Word 97*. As previously discussed, a simple pattern match is sufficient. (As previously noted, one well-known mechanism for doing such a pattern match is via a regular expression engine. A regular expression that might be used in conjunction with a regular expression engine to perform the operation indicated in *Word 97* is: (Dear|To)\s+\w+(;|,) which matches either "Dear" or "To" followed by one or more

CA9-99-017

PATENT

whitespaces, followed by one or more alphabetic characters followed by either a colon or comma.) The foregoing notwithstanding, the allegation does not meet the limitation of claim 22. Claim 22 recites at least one grammatical template file, each grammatical template file for specifying the manner of parsing and defining bounds of a section of the output document. All words in the claim must be considered when determining the patentability of the claim. MPEP § 2143.03. Indeed the Examiner admits that *Word 97* does not teach parsing. (Paper No. 7, page 9.) Nevertheless, the Examiner contends that *Word 97* teaches analyzing initial user inputted words and punctuation which provides the equivalent of parsing text components. (Paper No. 7, page 9.) This allegation fails for several reasons.

As an initial matter, asserting that *Word 97* teaches analyzing initial user inputted words and punctuation is an overstatement of the teaching in *Word 97*. *Word 97* teaches that if the user enters "Dear" or "To" followed by a name followed by a colon or comma, the "Letter Wizard" will start and ask the user if the user would like help. (*Word 97*, pages 2, 7, 9.) There is no evidence to support the alleged analysis of inputted words and punctuation, and indeed, the demonstration above contradicts this assertion. A rather simple pattern matching suffices to perform the operation illustrated in *Word 97* and there is no evidence in *Word 97* to the contrary.

Consequently, the Examiner's assertion that it "would have been obvious to interpret *Word 97* in this fashion" is unavailing. Obviousness is not shown by concluding that it would have been obvious to interpret the reference to teach a limitation of the claim. See e.g. MPEP § 2143 (stating that a *prima facie* showing of obviousness requires that (i) the reference or references must teach or suggest all of the limitations of the claim, (ii) there must be objective evidence of a motivation or suggestion to combine or modify the references to make the claimed invention, and (iii) there must be a reasonable expectation of success in combining or modifying the references to make the claimed invention.) The foregoing notwithstanding, the allegation does not address the elements of claim 22. Claim 22 does not recite parsing of components, but a grammar template file for specifying the manner for parsing and defining the bounds of a section of the output document. All words in the

CA9-99-017

PATENT

claim must be considered when determining the patentability of the claim. MPEP § 2143.03.

Claim 22 further recites a style template parsed from a user example document... The Examiner admits that *Word 97* does not teach templates for programming languages. (Paper No. 7, page 9.) As an initial matter, this does not address the limitations of claim 22. Claim 22 not recite templates for programming languages, without more. All words in the claim must be considered when judging the patentability of the claim. MPEP § 2143.03. The foregoing notwithstanding, the Examiner contends that *Borland* teaches a text editor for editing text and C++ programming files. (Paper No. 7, page 9.) Whether *Borland* does teach such a text editor is immaterial to the rejection of claim 22. There is no evidence, or even an allegation that *Borland* teaches templates as recited in claim 22. Consequently, *Borland* does not cure the admitted deficits in *Word 97*.

The Examiner further concludes that it would have been obvious to incorporate the specific editing of files associated with C++ to *Word 97* to provide *Word 97* with the benefit of enhancing its templates to accommodate various text files for programmers. (Paper No. 7, page 9.) This motivation is unavailing for several reasons. The modification of *Word 97* to incorporate the specific editing of files associated with C++ does not result in the invention of claim 22. Therefore, there is no motivation or suggestion to make the claimed invention. Moreover, the motivation or suggestion is not found in one of the three possible sources thereof. See MPEP § 2143.01. Additionally, a motivation or suggestion must be clear and particular, and broad, conclusory statements regarding the reaching of the references without more is not evidence. *In re Lee*, 377 F.3d at 1343, 61 U.S.P.Q.2d at 1433-34.

Thus claim 22 is not *prima facie* obvious in view of *Word 97* and *Borland*. Consequently, claim 22 is allowable under 35 U.S.C. § 103 over *Word 97* and *Borland*.

Claim 41 has been rejected on the same basis as claim 22 as being drawn to a system for performing the operations of the computer program product of claim 22.

CA9-99-017

PATENT

(Paper No. 7, page 10.) Therefore, for at least the same reasons as discussed in conjunction with claim 22, claim 41 is also allowable under 35 U.S.C. § 103 over *Word 97* and *Borland*.

CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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